

REMARKS

In response to the Non-Final Office Action mailed July 25, 2007 (hereinafter "Office Action"), claims 1, 4-5, 13-17, 20-38, and 40 were amended. No claims were cancelled or newly added. Pursuant to the Notice, the foregoing Amendment corrects the previously incorrect status identifier for claim 40. Therefore, claims 1-40 are pending, and no new matter has been added. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

INFORMATION DISCLOSURE STATEMENT

Applicant thanks the Examiner for considering the references cited in the Information Disclosure Statement filed on March 19, 2007, as evidenced by the signed and initialed copy of the PTO-1449 Form returned with the Office Action.

A Supplemental Information Disclosure Statement was filed by Applicant on August 16, 2007. Applicant respectfully requests that the Examiner consider the cited references and provide a signed and initialed copy of the Form PTO-1449 for this submission with the next Office Action.

REJECTIONS UNDER 35 U.S.C. § 101

Claims 1-39 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter [Office Action, pg. 2, ¶ 3].

A. The Examiner first alleges that:

The "means for" corresponds to software program elements and not tangible hardware components. Software program elements do not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101.

[Office Action, pg. 2].

Although Applicant disagrees with the propriety of this rejection, solely in an effort to expedite prosecution, independent claim 1 has been amended to further clarify various aspects of the invention. For example, independent claim 1 has been amended to recite, among other

things, that an alert is issued “via a graphical user interface displayed on a display device,” and that current estimate data is stored “in a data repository on a per analyst basis.” As such, independent claim 1 expressly recites “tangible hardware components” in the form of “a data repository” and “a display device.” The claimed invention therefore produces a “useful, concrete, and tangible result” because the recited hardware components tangibly embody the useful and concrete results recited therein.

Accordingly, for at least the foregoing reasons, the claimed invention does not merely “correspond[] to software program elements,” as the Examiner alleges. Rather, the combination of features recited in independent claim 1 produce a “useful, concrete, and tangible result,” thus satisfying the requirements of 35 U.S.C. § 101. For at least this reason, the rejection of claims 1-39 as allegedly being directed to non-statutory subject matter is legally improper and should be withdrawn.

B. The Examiner further alleges that:

Claims 1-39 merely recite elements of an apparatus or system (“means for” corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility.

[Office Action, pg. 3].

As discussed above, Applicant disagrees with the propriety of this rejection. Nonetheless, solely in an effort to expedite prosecution, independent claim 1 has been amended to further clarify various aspects of the invention. More particularly, the claimed invention does not recite functional descriptive material for at least the reason that independent claim 1 expressly recites various hardware components that tangibly embody the useful and concrete results recited therein. For example, independent claim 1 recites, among other things, that current estimate data is stored “in a data repository on a per analyst basis,” and that an alert is issued “via a graphical user interface displayed on a display device.”

Accordingly, for at least the foregoing reasons, the claimed invention is not “a disembodied data structure . . . or other functional descriptive material,” as the Examiner

alleges. Rather, the combination of features recited in independent claim 1 interact with various tangible hardware components, including at least “a data repository” and “a display device.” Therefore, because aspects of the claimed invention are expressly recited in connection with tangible hardware components, the claimed invention is not functional descriptive material *per se*. For at least this reason, the rejection of claims 1-39 as allegedly being inoperative and therefore lacking utility is legally improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-40 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention [Office Action, pg. 3, ¶ 5].

In particular, regarding the features recited in independent claim 1, the Examiner alleges that:

[I]t is not clear as to what is the relationship between the limitation of analyzing and the limitation of determining. It is not clear if the determining is performed regardless of the outcome of the analyzing step or if it is performed based on the analyzing step. Hence the scope of the claim is not clear.

[Office Action, pgs. 3-4].

Although Applicant disagrees with the propriety of this rejection, solely in an effort to expedite prosecution, independent claims 1 and 40 have been amended to further clarify various aspects of the invention. For example, independent claims 1 and 40 have been amended to recite, among other things, “analyzing the current estimate data to determine when one or more alert conditions are satisfied.” As such, the claimed invention clearly sets forth “the relationship between the limitation of analyzing and the limitation of determining.” In particular, the current estimate data is “anaylaz[ed] . . . to determine when one or more alert conditions are satisfied.” Accordingly, for at least this reason, the rejection of claims 1-40 under 35 U.S.C. § 112, second paragraph is legally improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,557,513 to Frey *et al.* ("Frey") [Office Action, pg. 4, ¶ 7]. Applicant traverses this rejection for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

A. Independent Claim 1.

With regard to independent claim 1, the Examiner alleges that Frey teaches each of the recited claim features, with the exception of the data comprising current estimate data for a plurality of analysts, the current estimate data including at least an estimate amount and when the estimate was made [Office Action, pg. 4].

The Examiner interprets the foregoing claim recitation as non-functional descriptive material, however, that is not afforded any patent weight:

[T]he *description of data* (data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made) *is interpreted as a non-functional descriptive material because it does not affect in any way the means for storing, analyzing, determining and issuing an alert. Hence the limitation "data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made" is not given patentable weight.* The prior art structure is capable of performing the intended function and hence it meets the claim.

[Office Action, pg. 4] [*emphasis added*].

The Examiner's rejection is legally improper for at least the reason that the Examiner has incorrectly alleged that the "current estimate data" recited in independent claim 1 "does not affect in any way the means for storing, analyzing, determining and issuing an alert." For example, independent claim 1 clearly recites, among other things, that "the current estimate data" is analyzed "to determine when one or more alert conditions are satisfied." Moreover, upon determining that the one or more alert conditions have been satisfied, independent claim 1 further recites "issuing, via a graphical user interface displayed on a display device, an

alert when at least one of the satisfied alert conditions further satisfy at least one predetermined alert condition for at least one of the plurality of analysts."

Therefore, the Examiner has improperly failed to accord patentable weight to the feature of "the current estimate data including at least an estimate amount and when the estimate was made." The Examiner has failed to set forth a proper rationale for disregarding a positively recited feature of the claimed invention, instead relying on the unfounded assumption that "[t]he prior art structure is capable of performing the intended function and hence it meets the claim." This rejection is improper for at least the reason that the Examiner has failed to apply the proper legal standard for establishing a *prima facie* case of obviousness.

More particularly, it is well established that "the examiner bears the initial burden, on review of the prior art or an any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (discussing *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984)). To meet the burden of establishing a *prima facie* case of obviousness, the issue is not whether the prior art is "capable of performing the intended function." Rather, the legally proper standard is whether the prior art "discloses, teaches, or suggests" each and every feature of the claimed invention, a burden which the Examiner has failed to meet.

Specifically, in addition to expressly acknowledging that "Frey does not explicitly disclose" the aforementioned features of the claimed invention, the Examiner does not even attempt to allege that Frey "teaches or suggests" such features in the absence of an explicit disclosure. For at least this reason the Examiner has failed to meet the burden of establishing a legally proper *prima facie* case of obviousness. However, because the reference does not disclose, teach, or suggest each and every feature of the claimed invention, the Examiner has instead chosen to rely upon factually incorrect assertions in the application of a legally improper standard. For example, the Examiner has improperly alleged that the "current estimate data" does not affect the features of "storing, analyzing, determining and issuing an alert," as independent claim 1 clearly recites that the current estimate data is stored "in a data

repository" and analyzed "to determine when one or more alert conditions are satisfied." Thus, the feature of "issuing . . . an alert" based on further analysis of the "satisfied alert conditions" is clearly recited as following from "analyzing the current estimate data."

Accordingly, for at least the reasons that the Examiner has applied a legally improper standard in alleging that a *prima facie* case of obviousness exists and improperly failed to give patentable weight to features expressly recited in the claim, the rejection of independent claim 1 under 35 U.S.C. § 103(a) is legally improper and should be withdrawn.

B. Dependent Claims 2-39.

In the Office Action, the Examiner makes a wholesale rejection of claims 2-39 by reciting that none of the claims are given any patentable weight:

Claims 2-39, *the feature in these claims describe the data further* and do not further limit the means for storing, analyzing, determining and issuing an alert. *Hence the limitations in these claims are interpreted as non-functional descriptive material and not given patentable weight.* The prior art structure is capable of performing these intended functions.

[Office Action, pg. 5] [*emphasis added*].

The rejection of dependent claims 2-39 is legally improper for at least the same reasons discussed above in reference to independent claim 1. For example, the Examiner's assertion that the features of claims 2-39 "describe the data further" is clearly erroneous, as the dependent claims are directed to, among other things, means for defining (e.g., claim 4), means for displaying (e.g., claims 13, 15, 18, 20), means for enabling a user to view alerts (e.g., claims 21-24), means for enabling a user to define or specify conditions, actions, or other parameters (e.g., claims 25-26, 32-33), means for issuing alerts to devices (e.g., claims 27-28), and means for enabling analysts to take actions (e.g., claim 37).

Despite the Examiner's allegations, these claims are directed to features that constitute more than simply further description of data. The Examiner's failure to address these claims on their merits constitutes a failure by the Examiner to meet his requisite burden of establishing a *prima facie* case of obviousness. The Examiner has not established that Frey discloses, teaches, or suggests any of these features, but has instead improperly alleged that

"the limitations in these claims are interpreted as non-functional descriptive material and not given patentable weight." The Examiner has taken a position that is not legally proper in the context of establishing a *prima facie* case of obviousness. Thus, for at least the reason that the Examiner has failed to even allege that Frey discloses, teaches, or suggests the features recited in dependent claims 2-39, the rejection thereof is legally improper and should be withdrawn.

C. Independent Claim 40.

With regard to independent claim 40, the Examiner alleges that Frey teaches each of the recited claim features, with the exception of the data comprising current estimate data for a plurality of analysts, the current estimate data including at least an estimate amount and when the estimate was made [Office Action, pg. 5].

In an attempt to remedy the acknowledged deficiencies of Frey, the Examiner invokes Official Notice:

Official notice is taken that the feature of data on a per analyst basis, current estimate data for a plurality of analysts, the data including at least an estimate amount and when the estimate was made is old and well known in the art. These estimates help investors stay informed and make informed decisions about their investment portfolio.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Frey to include these features. The combination suggests that investors would have benefited from being informed about the current earnings estimate on their investment and it would have helped them make informed decisions about their investment portfolio.

[Office Action, pgs. 5-6].

Applicant traverses the Examiner's invocation of Official Notice. In particular, even assuming *arguendo* that "current estimate data . . . including at least an estimate amount and when the estimate was made" could be characterized as "old and well known in the art," which Applicant does not concede, the Examiner has nonetheless failed to meet the burden of establishing the use of "current estimate" data recited in the claimed invention is "old and well known in the art." For example, the Examiner has failed to establish that it would have been

obvious “to determine when one or more alert conditions have been satisfied” by “analyzing current estimate data.”

In view of the foregoing, Applicants note that the Examiner may only “take [Official] notice of facts beyond the record which . . . are capable of such instant and unquestionable demonstration as to defy dispute.” *In re Ahlert*, 424 F.2d 1088, 1091 (C.C.P.A. 1970). As such, “[a]ssertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art,” and “[a]llegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported.” *Id.* at 1091 (emphasis added). Thus, for at least the aforementioned reasons, and pursuant to the requirements of 37 C.F.R. § 1.104(c), the Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (requiring Examiners to “point to some concrete evidence in the record” to support a finding based on common knowledge).

To legally meet the burden of supporting the “Official notice,” any such documentary evidence must establish that the features of “analyzing the current estimate data to determine when one or more alert conditions have been satisfied” and “issuing an alert when at least one of the satisfied alert conditions further satisfy at least one predetermined alert condition for at least one of the plurality of analysts” are old or well known. Alternatively, if the Examiner is relying upon personal knowledge as the basis for alleging “Official Notice,” the Examiner must provide support for the alleged personal knowledge by affidavit in the next Office Action. 37 C.F.R. § 1.104(d)(2). In the absence of any such documentary evidence or personal knowledge supported by sworn affidavit, the rejection of independent claim 40 under 35 U.S.C. § 103(a) is legally improper and should be withdrawn.

CONCLUSION

Having addressed each of the foregoing rejections, and having provided a Corrected Amendment to the Claims, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action. As such, prompt and favorable treatment on the merits is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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